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10/649,623	08/28/2003	Yousaku Ohta	2003_1215A	5299
52349 7590 08/01/2008 WENDEROTH, LIND & PONACK L.L.P. 2033 K. STREET, NW SUITE 800 WASHINGTON, DC 20006				
EXAMINER				
YALEW, FIKREMARIAM A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/649,623

**Applicant(s)**

OHTA ET AL.

**Examiner**

Fikremariam Yalew

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 17, 21-22, 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17, 21-22, 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/15/2008 has been entered.
2. Claims 1,17,21-22,24 have been amended. Claims 11-16,19,23 were previously canceled and claims 18-20,23 are canceled .Claims 1-10,17,21-22,24 are pending.
3. The Examiner withdrawal the previous specification rejection based on applicant amendment. The examiner also withdraws 35 USC 112 second rejections.

### **Response to Arguments**

4. Applicant's arguments with respect to claim 1-10,17, 21-22,24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 1 is directed a computer apparatus that manages a decryption key for decrypting an encrypted content and manages a supplyable number .Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention directed to non-statutory subject

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matter. Claim 1 is an apparatus claim without any structural component and consists solely of language that is implemented with only software. Claim 1 does not provide any functional interrelationship to any software and hardware structural components to provide certain function that is processed by a computer. Claim 2 do not cure the deficiency of the 35 USC 101 rejection and reject on the same rational.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2,21-22,24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Alve et al(hereinafter referred as Alve)US Pub No 2003/0076955 A1.

9. As per claims 1,21-22,24: Maeda discloses a key delivery apparatus/system/computer readable recording medium that manages a decryption key for decrypting an encrypted content and manages a suppliable number, which is a number indicating a number of times the decryption key can be supplied to a terminal apparatus connected to a network, the key delivery apparatus comprising:

a receiving unit operable to receive, from the terminal apparatus, a supply request which is a request for the decryption key(see 0058-0059 and Fig 3 step 14);and

a key supply unit operable, if the supplyable number indicate that the decryption key can be supplied, to supply to the terminal apparatus, (i)the decryption key and a key-usage period of the decryption key if the supply determining unit determines that the terminal apparatus is of the first-type and (ii)the decryption key without the key usage period, if the supply determining unit determines that the that the terminal apparatus is of second-type, wherein the supply determining unit determines that the terminal apparatus is of the first-type if the terminal apparatus records the encrypted content, the decryption key, and the key-usage period onto a portable recording medium(See 0042,0049).

Maeda does not explicitly teach a supply determining unit operable, if the terminal apparatus is a legitimate supply target, to determine whether the terminal apparatus is a terminal apparatus of a first-type that manages a content-usage period and whether the terminal apparatus is a terminal apparatus of a second-type that does not manage the content-usage period; if the supply determining unit determines that the that the terminal apparatus is of second-type, wherein the supply determining unit determines that the terminal apparatus is of the first-type if the terminal apparatus records the encrypted content, the decryption key, and the key-usage period onto a portable recording medium and imposes a restriction on usage of content and is related to the decryption key and a restriction on usage of content is not imposed on the terminal apparatus.

However Alve teaches a supply determining unit operable, if the terminal apparatus is a legitimate supply target, to determine whether the terminal apparatus is a

terminal apparatus of a first-type that manages a content-usage period and whether the terminal apparatus is a terminal apparatus of a second-type that does not manage the content-usage period (See 0060 and Fig 3a steps 300,310,312,320); if the supply determining unit determines that the that the terminal apparatus is of second-type, wherein the supply determining unit determines that the terminal apparatus is of the first-type if the terminal apparatus records the encrypted content, the decryption key, and the key-usage period onto a portable recording medium(See 0029,0038,0005 0060) and imposes a restriction on usage of content and is related to the decryption key and a restriction on usage of content is not imposed on the terminal apparatus(See 0004,0008,0038,0052).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the teaching method of Alve within Maeda method inorder to provide a flexible means for allowing content providers to dictate allowable uses of licensed content(See Alve 0019).

10. As per claim 2: the combination of Maeda and Alve disclose the key delivery apparatus wherein the network is a home network connected to an external network; content is received from outside the home network; and the key delivery apparatus determines whether each terminal apparatus connected to the home network is be legitimate supply target (See Maeda Fig 3 steps 21,1,s4 and 0002,0056).

11. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Alve et al(hereinafter referred as Alve)US Pub No 2003/0076955 A1**

12. As per claim 17: Maeda discloses portable recording medium that receives supply of a decryption key for decrypting an encrypted content from a key delivery apparatus that manages the decryption key to the portable recording medium comprising:

a key reception unit operable to receive the decryption key and a key-usage period of the decryption key from the key delivery apparatus, when the key delivery apparatus determines that supplying the decryption key to the portable recording medium is possible(See 0055,0058-0059,0089); a key-information storage unit operable to store the decryption key and the key-usage period(See 0042,0049)

Maeda does not explicitly teach a proprietary determining unit operable to receive, from the key delivery apparatus, search information identifying the decryption key, and operable to determine whether the decrypted key is stored on the portable recording medium based on the search information; and a proprietary notifying unit operable to transmit, to the key delivery apparatus, information indicating that the decryption key stored on the portable recording medium being transmitted when the proprietary determining unit determines that the decryption key is stored on the portable recording medium.

However Ito teaches a proprietary determining unit operable to receive, from the key delivery apparatus, search information identifying the decryption key, and operable to determine whether the decrypted key is stored on the portable recording medium based on the search information(See abstract and col 2 lines 8-26); and a proprietary notifying unit operable to transmit, to the key delivery apparatus, information indicating

that the decryption key stored on the portable recording medium being transmitted when the proprietary determining unit determines that the decryption key is stored on the portable recording medium(See abstract and col 2 lines 8-26).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the teaching method of Ito within Maeda method in order to enhance security of the system.

**13. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Alve et al(hereinafter referred as Alve)US Pub No 2003/0076955 A1 and further in view of Marshall et al(hereinafter referred as Marshall) US Patent No 4,866,707**

14. As per claim 3: Maeda and Alve disclose claim 1 as recited above. Maeda and Alve do not explicitly teach the key delivery apparatus further comprising: a key-information storage unit operable to store the key-usage period subsequent to the key supply unit supplying the decryption key and the key-usage period to the terminal apparatus of the first-type; a period determining unit operable to determine whether the key-usage period has expired; and a time management unit operable to add "1" to the supplyable number when the period determining unit determines that the key-usage period has expired.

However Marshall discloses the key delivery apparatus further comprising: a key-information storage unit operable to store the key-usage period subsequent to the key supply unit supplying the decryption key and the key-usage period to the terminal apparatus of the first-type(col 7 lines 17-29); a period determining unit operable to



determine whether the key-usage period has expired(col 7 lines 17-29); and a time management unit operable to add "1" to the suppliable number when the period determining unit determines that the key-usage period has expired(See col 7 lines 17-29).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the teaching method of Maeda to include a key-information storage unit operable to store the key-usage period subsequent to the key supply unit supplying the decryption key and the key-usage period to the terminal apparatus of the first-type; a period determining unit operable to determine whether the key-usage period has expired; and a time management unit operable to add "1" to the suppliable number when the period determining unit determines that the key-usage period has expired.

This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, (See Maeda 0009) in order to prevent the improper usage of contents.

**15. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Alve et al(hereinafter referred as Alve)US Pub No 2003/0076955 A1 and further in view of Marshall et al(hereinafter referred as Marshall) US Patent No 4,866,707 further in view of Mooney et al(hereinafter referred as Mooney) US Patent No 6,351,813 B1.**

16. As per claim 4: the combination of Maeda- Alve-Marhsall teach claim 3 as recited above. The combination of Maeda- Alve-Marhsall do not explicitly teach the key delivery

further comprising: a date-time storage unit operable to store at least one of a first group and a second group, the first group including (i) date-time information indicating the key-usage period and a supply date-time of the decryption key, and (ii) identification information indicating the supply target to be the terminal apparatus of the first-type, and the second group including (i) date-time information indicating the supply date-time of the decryption key, and (ii) identification information indicating the supply target to be the terminal apparatus of the second-type; a date-time determining unit operable to determine whether a present date-time has reached the supply date-time; and a date-time supply unit operable, when the date-time determining unit determines that the present date-time has reached the supply date-time, to supply the decryption key and the key-usage period to the terminal apparatus of the first-type or supply the decryption key to the terminal apparatus of the second-type, based on the identification information.

However Mooney discloses the key delivery further comprising: a date-time storage unit operable to store at least one of a first group and a second group, the first group including (i) date-time information indicating the key-usage period and a supply date-time of the decryption key, and (ii) identification information indicating the supply target to be the terminal apparatus of the first-type, and the second group including (i) date-time information indicating the supply date-time of the decryption key, and (ii) identification information indicating the supply target to be the terminal apparatus of the second-type (See col 10 lines 27-35); a date-time determining unit operable to determine whether a present date-time has reached the supply date-time (See col 10 lines 27-35);

and a date-time supply unit operable, when the data time determining unit determines that the present date-time has reached the supply date-time, to supply the decryption key and the key-usage period to the terminal apparatus of the first-type or supply the decryption key to the terminal apparatus of the second-type, based on the identification information(See col 10 lines 27-35).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Mooney within the combination of Maeda-Alve-Marshall method in order to prevent the improper usage of content.

17. As per claim 5: the combination of Maeda-Alve-Marshall-Mooney discloses the key delivery further comprising: a search requesting unit operable to transmit, to the terminal apparatus of the first-type and the terminal apparatus of the second-type, search information identifying the decryption key (See Maeda 0049-0051); and a proprietary information receiving unit operable to receive information indicating whether the decryption key is stored by the terminal apparatus of the first-type or the terminal apparatus of second-type(See Maeda 0039-0041).

18. As per claim 6: the combinations of Maed-Alve-Marshall-Mooney discloses the key delivery apparatus wherein the key delivery apparatus stores secret information, which is information to be used as a reference when determining whether the terminal apparatus is a legitimate supply target; the supply determining unit includes an authentication subunit operable to determine whether the terminal apparatus is storing the secret information; and the supply determining unit determines

that the terminal apparatus is the legitimate supply target when determines that the terminal apparatus is storing the secret information(See 0058-0060 and Fig 3a steps 300,310,312,320).

19. As per claim 7: the combinations of Maeda-Alve-Marshall-Mooney discloses the key wherein the key supply unit includes a remaining number determining subunit operable to determine whether the suppliable number is greater than a predetermined reference number; and the key supply unit determines that the suppliable number indicates that the decryption key can be supplied when the key supply unit determines that the suppliable number is greater than the predetermined reference number (See Maeda Fig 4 steps 1001,1002, Fig 5 steps 2000-2002).

20. As per claim 8: the combinations of Maeda-Alve-Marshall-Mooney discloses the key delivery apparatus wherein the key supply unit further includes an encryption subunit operable(i) to encrypt the decryption key and the key-usage period when the decryption key and the key-usage period are to be supplied the terminal apparatus of to the first-type, and(ii) to encrypt the decryption key when the decryption key is to be supplied to terminal apparatus of the second-type, and the key supply unit, when the key supply unit determines that the suppliable number has indicates that the decryption key can be supplied, supplies to the terminal apparatus,(i) the encrypted decryption key and the encrypted key-usage period when it is determined that the terminal apparatus is of the first-type and (ii)the encrypted decryption key when it is determined that the terminal apparatus is of the second-type (See Maeda 0055,0058-0059,0089).

21. As per claim 9: the combinations of Maeda-Alve-Marshall-Mooney disclose the key delivery apparatus further comprising: a historical information storage unit operable to store historical information indicating a connection date-time of the terminal apparatus of the first-type (See Marshall col 7 lines 17-2); a connection determining unit operable to determine, using the connection date-time, whether the terminal apparatus of the first-type was connected to the network within a predetermined connection period(See Marshall col 7 lines 17-2); and a connection management unit operable to add "1" to the suppliable number when it is determined that the terminal apparatus of the first-type was not connected to network within the predetermined connection period(See Marshall col 7 lines 17-2).

**22. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Alve et al(hereinafter referred as Alve)US Pub No 2003/0076955 A1 and further view of Marshall et al(hereinafter referred as Marshall) US Patent No 4,866,707 and further in view of Mooney et al(hereinafter referred as Mooney) US Patent No 6,351,813 B1.**

23. As per claim 10: the combination of Maeda-Alve-Marshall-Mooney disclose claim 8 as recited above. The combination of Maeda-Alve-Marshall-Mooney do not explicitly disclose the key delivery apparatus further comprising: a frequency storage unit operable to store a usage frequency of the decryption key by the terminal apparatus of the first-type; a frequency determining unit operable to determine whether the usage frequency has reached a predetermined reference frequency; and a connection

management unit operable to add "1" to the suppliable number when it is determined that the usage frequency has reached the predetermined reference frequency.

However Hamada discloses the key delivery apparatus further comprising: a frequency storage unit operable to store a usage frequency of the decryption key by the terminal apparatus of the first-type (See 0020,0028); a frequency determining unit operable to determine whether the usage frequency has reached a predetermined reference frequency; and a connection management unit operable to add "1" to the suppliable number when it is determined that the usage frequency has reached the predetermined reference frequency(See 0020,0028).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Hamada within the combination of Maeda-Alve-Marshall-Moony method in order to protect a copy right for a content provider when the content data is moved or paused (See Hamada 0011)

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fikremariam Yalew whose telephone number is 5712723852. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser can be reached on 571-272-4195. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fikremariam Yalew  
07/25/2008  
FA

Art Unit 2136

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